

REMARKS

Claims 1-8, 16 and 18-23 are pending in the case. Applicants have hereinabove amended claims 1-7 and 20-23. Accordingly, upon entry of this Amendment, claims 1-8, 16 and 18-23, as amended, will be pending and under examination.

Applicants maintain that the amendments to claims 1-7 and 20-23 do not raise any issue of new matter, and that such amendments are fully supported by the specification as originally filed. Support for the claim amendments for claims 20-21 is found, *inter alia*, in the specification as follows: second paragraph on page 1; paragraph bridging pages 1 and 2.

Moreover, in making these amendments, applicants neither concede the correctness of the Examiner's objection or rejections in the June 24, 2008 Non-Final Office Action, nor abandon the right to pursue in a continuing application embodiments of the instant invention no longer claimed in this application.

In view of the remarks/arguments set forth below, and amendments to the claims hereinabove, applicants submit that the Examiner's objection and rejections made in the June 24, 2008 Non-Final Office Action have been overcome and respectfully request that the Examiner reconsider and withdraw these grounds of objection and rejections.

Claim Objections

The Examiner objects to claim 7 under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only.

In response to the Examiner's above objection, but without conceding the correctness thereof, applicants note that claim 7 has been amended, and as a result, does not recite "... in claim 1 and 2." Thus, in light of the above, the Examiner's objection is obviated.

Claim Rejection Under 35 U.S.C. § 112, First Paragraph (Enablement)

The Examiner states that claims 20-23 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which as not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner states that the specification, while being enabling for a method of treating a bacterial infection due to *Staphylococcus aureus*, allegedly does not reasonably provide enablement for a method of treating bacterial infection generally.

In response to the Examiner's rejection, but without conceding the correctness thereof, applicants point out that claims 20-23 have been amended.

Claims 20-23, as amended, identify a common mechanism by which bacterial infections conditions arise -- infections caused by bacteria which are sensitive to inhibition of their dihydrofolate reductase enzyme activity. Applicants note that the specification contains the requested correlation between *in vitro* data obtained through application of the assay system disclosed in the specification and the treatment of specified types of bacterial infections and diseases or disorders embraced in claims 20-23, as amended.

In view of the arguments above, applicants maintain that claims 20-23, as amended, satisfy the requirements of 35 U.S.C. § 112, first paragraph, and request that the Examiner reconsider and withdraw this rejection.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph (Indefiniteness)

The Examiner states that claims 1-8, 16 and 18-23 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claims the subject matter which applicants regard as an invention.

In response to the Examiner's above rejection, but without conceding the correctness thereof, applicants note that claims 1-7 have been amended in accordance with Examiner's recommendations.

In view of the arguments above, applicants maintain that claims 1-8, 16 and 18-23, as amended, satisfy the requirements of 35 U.S.C. § 112, second paragraph, and request that the Examiner reconsider and withdraw this rejection.

Claim Rejection Under 35 U.S.C. § 103(a) (Obviousness)

The Examiner states that claims 1-6, 8, 16 and 18-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burri et al. (WO 02/10156).

In response to the Examiner's above rejection, but without conceding the correctness thereof, applicants note that claims 1-6, 16 and 18-23 have been amended. Additionally, applicants respectfully traverse.

To the extent a proper *prima facie* case were made by the Examiner, which applicants do not concede, applicants maintain that the evidence of unexpected superiority discussed below would overcome such case.

The claimed invention has unexpected advantageous properties, e.g., a surprisingly superior antibacterial activity as compared to the compounds of Burri et al.

In support of his position, applicants attach hereto as **Exhibit A** a Declaration of Dr. Stephen Hawser under 37 C.F.R. § 1.132. In the Declaration, Dr. Hawser establishes the following:

1. That he and/or individuals under his direction performed the following experiments to obtain and compare minimal inhibitory concentrations ("MIC") results between claimed compounds of the present invention and compounds disclosed in Burri et al. Specifically, antimicrobial susceptibility testing, as described in "General Procedure E: Measurement of antimicrobial activity" on PCT International Publication No. WO 2005/005418 (which is also on page 20, ll. 1-9 of the subject application), was conducted on exemplary compounds of the present invention and the compounds of Burri et al. (see page 1, lines 28-30). A copy of the relevant pages of PCT International Publication No. WO 2005/005418 is attached as **Exhibit 2** of the Declaration. ATCC *Streptococcus pneumoniae* 49619 bacterial strain was used during the antimicrobial susceptibility testing.

2. The identity of the compounds tested, as well as the results of the antimicrobial susceptibility tests of exemplary compounds of the present invention in comparison with the compounds disclosed in Burri et al. are attached as **Exhibit 3** of the Declaration.

3. As shown in **Exhibit 3** of the Declaration, the results of the susceptibility tests indicate that exemplary compounds of the present invention have significantly superior antibacterial activity as compared to the compounds disclosed in Burri et al.

The results shown in **Exhibit 3** of the Declaration are dramatic and underscore the surprising and unexpected nature of applicants' invention. Applicants maintain that one of ordinary skill in the art, based on Burri et al., could not have predicted the significantly superior antibacterial activity of the present invention so dramatically demonstrated in the attached Declaration.

Accordingly, the Examiner has failed to establish obviousness, *prima facie* or otherwise, of claims 1-6, 8, 16 and 18, as amended, over the Burri et al.

In view of the above arguments, applicants maintain that claims 1-6, 8, 16 and 18-23, as amended, satisfy the requirements of 35 U.S.C. § 103(a).

Application No. 10/563,938
Amendment in Response to June 24, 2008 Non-Final Office Action and
Petition For A One-Month Extension of Time

Docket No.: A0039.0001

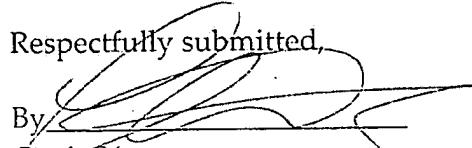
Conclusion

In light of all of the foregoing, it is respectfully submitted that this application is now in condition to be allowed and the issuance of a Notice of Allowance is respectfully solicited.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

Dated: October 24, 2008

Respectfully submitted,

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